

AMENDMENT & RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE

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Dkt: 450.224US1

Serial Number: 09/002,600

Filing Date: January 5, 1998

Title: SYSTEM AND METHOD FOR REMINDING USERS OF UPCOMING SCHEDULED RECORDINGS**REMARKS**

Claims 11, 17, 21 and 24 have been amended. No claims have been cancelled, and no claims have been added. As a result of the amendment, claims 1, 2, 4-13, 15-17, 20, 21, 24 and 26 are pending in this application.

Applicant reserves all applicable rights not exercised in connection with this response.

Response to §102 Rejections

Claims 11, 13, 17, 21 and 24 were rejected under 35 USC § 102(b) as anticipated by Young (U.S. 4,706,121).

In response, claim 11, 17, 21, and 24 have been amended to more readily distinguish over Young. Specifically, the claims were amended in accord with the Examiner's statement on page 7 of the Action that "Young fails to explicitly disclose the method of receiving user input at least partially determinative of a recording reminder time for the scheduled recording and non-determinative of the recording time." As a result each now requires "means for receiving user input regarding a recording reminder, with the user input being non-determinative of the recording time." "receiving user input at least partially determinative of a recording reminder time for a scheduled automatic data recording and non-determinative of a time for initiating the scheduled data recording," or "receiving two or more user remind-time inputs, with each user input associated with at least one of the scheduled recordings and each user input non-determinative of a time for initiation of an automatic recording." Thus, the amended claims distinguish from Young for the reasons expressly acknowledged by the Examiner.

Accordingly, applicant respectfully requests that the Examiner withdraw the §102 rejections.

Response to §103 Rejections based on Young & Ellis

Claims 1-2, 8-11, 13, 17, 21, 24 and 26 were rejected under 35 USC § 103(a) as unpatentable over Young (U.S. 4,706,121) in view of Ellis. (U.S. 6,275,268); claims 4-6 were rejected as unpatentable over Young in view of Ellis and Hoff (U.S. 5,467,197); and claim 7 was

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rejected as unpatentable over Young (U.S. 4,706,121) in view of Ellis (U.S. 6,275,268) and further in view of Strubbe. (U.S. 5,047,867).

However, applicant traverses on the grounds that one of ordinary skill would not modify Young based on Ellis as proposed by the Examiner. In particular, Young already has a fixed reminder system which sounds an alarm a predetermined time period prior to a scheduled program or recording. See, for example, column 8, lines 15-19, which indicates that an alarm is sounded to remind a viewer to view a program and column 20, lines 50-53, which indicates sounding of the alarm prior to a recording. The Examiner proposes (at page 8 of the Action) that one would modify Young to include Ellis's remind feature to "provide the desirable advantage of preventing the user from failing to view (or record) a program." Yet, Young already provides this advantage. Thus, there's no motivation for one to modify Young pursuant to the proposed advantage.

MPEP 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), dictates that

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the [cited] reference (or references when combined) must teach or suggest all the claim limitations.

Thus, without a valid motivation, the 103 rejection based on Young and Ellis fails to establish a *prima facie* case of obviousness.

Moreover, Ellis appears only to provide its reminder for viewing programs, not for viewing and reminding. The passage cited by the Examiner (col. 15, lines 17-57) doesn't indicate that the reminders are given for programs that are scheduled for recording. This is contrary to the Examiner's parenthetical suggestion that Ellis reminds users about scheduled recording sessions. The fact is Ellis fails to teach this precise form of user reminder. Thus, even if the Examiner's motivation were valid, the proposed modification of Young to include Ellis's viewing reminder would not meet all the requirements of the rejected claims.

Accordingly, applicant respectfully request that the 103 rejections based on Young and Ellis be withdrawn.

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In further response to the rejection of claims 4-6 based on Young, Ellis, and Hoff, applicant submits that the Action fails to cite sufficient motivation for combining Hoff with Young and Ellis. The Action states (in the paragraph bridging pages 10 and 11) that "it would have been obvious to one of ordinary skill in the art to further modify Young ... to output messages to a network communication device, as taught by Hoff, which would increase the capability of Young thereby making Young more commercially attractive." However, no teaching or suggestion is cited to support that Young would be more commercially attractive with the addition of Hoff. Moreover, MPEP 2144 states that an appropriate motivation may be reasoned from common knowledge in the art, scientific principles, art-recognized equivalents, or legal precedent. There is no mention of marketing principles or commercial attractiveness. Thus, the Action fails to establish a *prima facie* case of obviousness for claims 4-6.

Accordingly, applicant submits that there is additional grounds for withdrawing the 103 rejection of claims 4-6.

Response to §103 Rejections based on Young & Hoff and Young & Strubbe

Claims 12 and 15 were rejected under 35 USC § 103(a) as unpatentable over Young in view of Hoff, and claims 16 and 20 were rejected similarly over Young in view of Strubbe.

These rejections stand moot with the amendment of claim 11 to more readily distinguish from Young. Accordingly, applicant requests that the rejections of claims 12, 15, 16, and 20 also be withdrawn.

Request for Withdrawal of Finality

Pursuant to MPEP 706.07(a), applicant respectfully requests withdrawal of finality of the rejections based on Ellis, a newly cited reference, and the non-amendment of claims 2, 4-13, 15-17, 20, 21, 24, and 26 in the previous Amendment. MPEP 706.07(a) states that "a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art."

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Therefore, applicant submits that according to the MPEP, the present finality was improper and urges its withdrawal.

Conclusion

In view of the amended claims and foregoing remarks, applicant respectfully requests entry of the amendment, reconsideration of the application, and withdrawal of all rejections. Moreover, applicant invites the Examiner to call its patent counsel, Eduardo Drake (612-349-9593) to address any issues that may impede allowance.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

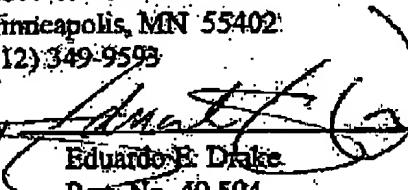
THEODORE D. WUGOFSKI

By their Representatives,

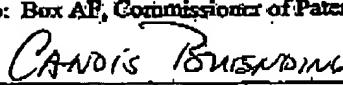
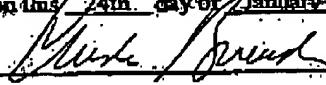
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The undersigned hereby certifies that this correspondence is being transmitted by facsimile (FAX NO. 703-872-9314) to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 24th day of January, 2000.


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